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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Inventors: Wong, et al.

SC/Serial No.: 09/847,005

Confirm. No.: 5364

Filed: May 2, 2001

Title: Network Communication System Using Assigned
Timeslots For Nodes To Request A Bandwidth
Amount For Data Transmission With Resulting
Grant For The Node To Transmit

PATENT APPLICATION

Art Unit: 2686

Examiner: Moore, James K.

Customer No. 23910

RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. § 1.116

Commissioner for Patents
Washington, D.C. 20231

Sir:

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This is a response to an Office Action mailed June 17, 2004 for the above identified application.

I. Section 112 Rejection

In the Office Action, claims 46-125 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action states indicates that claim 46 includes the limitations "said first request signal including a request for a specified amount of bandwidth to be allocated to the first node for transmitting data from the first node to the communication controller" and "transmitting a second signal from the communication controller to the first node in response to the first request signal, said second signal allocating at least one timeslot to the first node for transmitting the data to the communication controller." The Office Action further states that claims 49, 62, 65, 78, 81, 94 and 97 also include these limitations. The Office Action indicates these limitations

were not described in the specification. Based on the following remarks, this rejection is respectfully traversed.

A. First Claim Phrase - "First Request Signal"

Regarding the first claim phrase identified by the Office Action, "said first request signal including a request for a specified amount of bandwidth," Applicants submit two attached declarations under 37 C.F.R. 132: (1) A declaration by Dr. Udo Pooch (hereafter "Declaration of Dr. Pooch"); and (2) A declaration by Mr. Samuel Wood (hereafter "Declaration of Mr. Wood").

As indicated in M.P.E.P. 2163 II A 3 (b), a Written Description Rejection under 35 U.S.C. 112, first paragraph for a claim limitation can be overcome if "[A] person of ordinary skill would have understood, at the time the present application was filed that the description requires that limitation." The M.P.E.P. cites *Hyatt v. Bonne*, 146 F.3d 1348, 1535, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998) for this proposition. Accordingly, the Declaration of Dr. Pooch and the Declaration of Mr. Wood are submitted to present evidence that a person of ordinary skill at the time of the invention would believe the first claim phrase was required from a reading of the original specification.

The Declaration of Dr. Pooch submits evidence of his background supporting that he was a person of ordinary skill in the art relating to the present application at the earliest priority date for the present invention in June of 1994. Dr. Pooch then reviewing the current claims and original specification states that the specification that page 6, lines 9-14 reveals the data transmissions described are conventional packet type transmissions. He further reveals from his knowledge at the earliest priority date for the invention of June 1994, that the present application request-grant process for packet transmissions would need a request that included a total amount of bandwidth needed for transmission so that control would be provided to prevent page messages from being interleaved on f3. He finds that such bandwidth control is particularly required to avoid long dead spaces or interleaving due to

more data typically being transmitted using a keyboard and display. Accordingly, Dr. Pooch concludes from his background up to June of 1994 and reading of the specification that the system described requires the limitation of “said first request signal including a request for a specified amount of bandwidth.”

The Declaration of Mr. Wood further submits evidence of his background supporting that he was a person of ordinary skill in the art relating to the present application at the earliest priority date for the present invention in June of 1994. Mr. Wood then reviewing the current claims and specification expands on Dr. Pooch’s declaration stating that with paging systems transmitting packets described in an environment with propagation delays as a result of distance measured in miles, a bandwidth allocation provided with the request would be understood by a skilled artisan to be necessary or required for the system to function properly. He states that without such a bandwidth allocation provided with the transmission request from a node, propagation delays would create large time gaps between transmissions. With the bandwidth request transmitted by the node, the controller can allocate space for data transmission in an efficient manner leaving no gaps. Accordingly, Mr. Wood concludes from his background knowledge prior to June of 1994 and reading of the specification that it is a requirement of the system disclosed to have “said first request signal including a request for a specified amount of bandwidth,” for the system to function properly.

Based on the declarations submitted from Dr. Pooch and Mr. Wood, Applicants maintain that “[A] person of ordinary skill would have understood, at the time the present application was filed that the description requires that limitation” for the first claim limitation “first request signal including ... bandwidth” as required under M.P.E.P. 2163 II A 3 (b) to support that the specification provides an adequate written description under 35 U.S.C. 112, first paragraph.

B. Second Claim Phrase -“Second Signal”

Regarding the second claim phrase language addressed by the Office Action “said second signal allocating at least one time slot to the first node for transmitting the data to the communication controller,” Applicants maintains that this claim language is inherent from the original specification as required under M.P.E.P. 2163.07(a) to overcome a Written Description Rejection.

As indicated in M.P.E.P. 2163.07(a), a Written Description Rejection under 35 U.S.C. 112, first paragraph can be overcome if the claim language is inherent from the original specification. As indicated under M.P.E.P. 2163.07(a), “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference....’ Inherency, however, may not be established by probabilities or possibilities.” The M.P.E.P. cites *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) for this proposition. In other words, inherency results when it is 100% certain that an event will occur from the specification, even if it is not specifically stated. As stated by the M.P.E.P. Section 2163.07(a), with inherency, the specification can be amended to include the inherent language without generating “new matter.”

The Office Action states “The specification discloses only that the second signal contains an op code which commands/authorizes the pager to send it message, and is silent to any indication of timeslots.” The Office Action particularly references page 13, lines 5-13 of the specification. With the present claim language, however, Applicants maintain that a specific indication of an amount of timeslots in the specification is not required to support the “second signal” language.

Inherency is established for this second claim phrase by the original specification. As indicated on page 13, lines 5-13, and as referenced by the Office Action, the “second signal” provides a “grant” on frequency f_2 to transmit. As indicated on page 13, lines 14-20, in response to the “second signal” the data is transmitted on frequency f_3 . The “grant” on f_2 as

well as the data transmitted in response on f_3 can be seen in Fig. 6. Transmission could then end on f_3 automatically without any further indication from the "second signal."

Thus, based on this original specification content "one or more time slots are granted" by the "second signal" beginning immediately on f_3 after the grant is received for it to transmit its data. Transmission of the second signal with an "op-code" alone will be sufficient to allocate one or more time slots occurring on f_3 after receipt of the second signal. Such an allocation is 100% certain based on the description indicating that the "second signal" is transmitted and in response the data is transmitted in space on f_3 beginning after receipt of the "second signal." Thus, the claim language "said second signal allocating at least one time slot" is inherent from the original specification language.

Based on the above remarks Applicants maintain that claims 46-125 are allowable as providing an adequate written description under 35 U.S.C. 112, first paragraph.

II. Conclusion

In light of the above remarks, claims 46-125 are now all believed to be in condition for allowance. Accordingly, reconsideration and allowance of these claims is respectfully requested.

Respectfully submitted,

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